

## REMARKS

In the office action mailed Jan. 19, 2004, Examiner states in Office Action Summary, and under 1 b) of the Detailed Action section (page 2) that Claims 1-3, 6-7, 10-20 are pending. However, Applicants respectfully point out that claim 16 had been previously canceled, and its inclusion in the Office Action Summary and the Detailed Action is improper.

### *Rejections under 35 U.S.C. § 102 (b)*

Examiner alleges that claims 1, 2, 6-7, 10-13, 15 and 19 are anticipated by Harris et al. (USPN. 5,985, 829) under 35 U.S.C. § 102 (b). Applicants disagree. In Harris et al., compounds are screened for their ability to induce apoptosis. Harris et al. do not teach, describe, or imply screening for any biological functions other than those related to apoptosis. The present invention as claimed encompasses screening compounds for their ability to modulate *any* function. Thus the scope of the present invention far exceeds the scope described by Harris et al.

The Examiner further alleges that Harris et al. teach measuring expression of at least two, three, or more genes in each cell type. However, the text sections referenced by the Examiner do not support Examiner's assertion. The RNA polymerase II and ATPase enzymatic activities (column 6, line 5-20) are measured, not the expression, *i.e.*, the abundance of the cellular mRNA encoding these enzymes. Likewise, helicase activity, not expression, is measured. Therefore, Harris et al. do not describe measuring expression of at least two genes or three genes or more genes in each cell type. The present invention as claimed is therefore not anticipated by Harris (USPN. 5,985,829), and the rejection of claims 1, 2, 6-7, 10-13, 15 and 19 must be withdrawn.

### *Rejections under 35 U.S.C. § 102 (e)*

Claims 1-3, 7, and 10 have been rejected under 35 U.S.C. § 102 (e) as being anticipated by Garner (USPN. 6,657,758). The Examiner erroneously alleges that "UV radiation" falls into the definition of "compound". Applicants respectfully disagree. UV radiation is not a compound. As defined in the specification, a test compound is "small molecules (typically molecules with molecular weights less than 1000 kDa) or larger macromolecules such as

polynucleotides (including ribozymes) and polypeptides.” See Specification at page 2. Additionally, the following is the definition of “compound” given in Encyclopædia Britannica: “Any substance composed of identical molecules consisting of atoms of two or more elements.” UV radiation is not a substance composed of molecules consisting of atoms. Compounds are chemical matter. UV radiation is not chemical matter. The present invention as claimed is therefore not anticipated by Garner (USPN. 6,657,758). The rejection of claims 1-3, 7, and 10 under 35 U.S.C. § 102 (e) is improper and must be withdrawn.

***Rejections under 35 U.S.C. § 103(a)***

The Examiner has maintained rejections of claims 1-3, 6-7, 10-15, and 17-20 under 35 USC 103(a) as being unpatentable over Johnson et al. (WO 99/37817) in view of Kamb et al. (USPN. 5,998,136). Applicants disagree. The Examiner states that Johnson teaches use of B-Cells, T-cells and astrocytes. Without acceding to the propriety of the rejection, and simply to facilitate allowance, claims 1 and 19 have been amended such that T-cells, B-cells and astrocytes are no longer among the cell types specifically recited in the claims. Furthermore, claim 17 has been amended such that it no longer recites HepG2 cells which are described by Johnson. The rejection should therefore be withdrawn. Accordingly, as claims 2-3, 6-7, 10-15, 17-18, and 20 are all dependent from either claim 1 or claim 19, the rejection of these claims is also moot and should be withdrawn.

Claims 3 and 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Harris (USPN. 5,985,829) in view of Friend (USPN. 6,303,291). Applicants disagree. As stated above, Harris does not teach or suggest the claimed invention as Harris does not disclose measuring gene expression as required by the claims. Friend does not cure this deficiency. Furthermore, the Examiner alleges that Friend teaches contacting the cell types with two or more test compounds. The Examiner cites column 4, lines 58-60 in Friend. Applicants disagree. The cited text describes a process of identifying primary targets by contacting the cells with each compound individually (according to the first embodiment), and then comparing the primary targets thus identified for each drug. Claim 14 of the present invention is drawn to contacting the cell types with two or more compounds simultaneously. The rejection of claims 3 and 14 under 35 U.S.C. § 103(a) is therefore improper and must be withdrawn.

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Claims 18 and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Harris (USPN. 5,985,829) in view of Aller (USPN. 6,479,241). Applicants disagree. As stated above, Harris does not teach or suggest the claimed invention as Harris does not disclose measuring gene expression as required by the claims. Aller does not cure this deficiency. Consequently, Applicants respectfully request that the rejection of claims 18 and 20 under 35 U.S.C. § 103(a) be withdrawn.

The Examiner has rejected claim 17 under 35 U.S.C. 103(a) as being unpatentable over Harris et al. in view of Johnson et al (WO 99/37817). Applicants disagree. As stated above, Harris does not teach or suggest the claimed invention as Harris does not disclose measuring gene expression as required by the claims. Johnson does not cure this deficiency. Furthermore, the Examiner correctly states that Harris et al. did not teach the cell types selected from the group according to claim 17. The Examiner also states that Johnson et al., teach cell types recited in claim 17 of the present invention. However, Claim 17 has been amended such that it no longer recites HepG2 cells which are described by Johnson. The combination of Harris and Johnson ~~does~~ therefore no longer result in the invention of claim 17, and the rejection should be withdrawn.

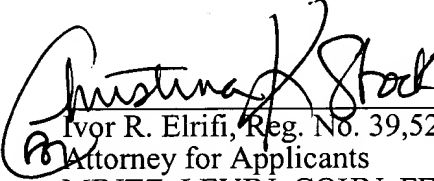
Claims 1, 17 and 19 have been amended. No new matter has been added. Claims 1-3, 6, 7, 10-15, and 17-20 are before the Examiner.

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### CONCLUSION

On the basis of the foregoing amendments and remarks, Applicants respectfully submit that this paper is fully responsive and that the pending claims are in condition for allowance. Such action is respectfully requested. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

  
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